



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/698,140 | 10/31/2003 | James D. Peterson | 020425-105900US | 2938 |
| 20350 | 7590 | 09/17/2008 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP | | | WONG, ERIC TAK WAI | |
| TWO EMBARCADERO CENTER | | | | |
| EIGHTH FLOOR | | | ART UNIT | PAPER NUMBER |
| SAN FRANCISCO, CA 94111-3834 | | | 3693 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 09/17/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/698,140 | PETERSON ET AL. | |
| | Examiner | Art Unit | |
| | ERIC T. WONG | 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 July 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-6,8-15,17-25 and 27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 3-6, 8-15, 17-25, 27 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim depends from canceled claim 16. Examiner interprets the claim as depending from independent claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 3, 6, 8, 9, 10, 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (US Patent 6,018,722), further in view of Reese (US Patent 6,236,980), further in view of Hoffman, (US Patent 7,249,080).

Regarding claim 1,

Ray teaches receiving a risk tolerance for a client; receiving preferences for the client (see column 4 line 66 – column 5 line 4); identifying assets held in the client's portfolio; based on the preferences and the risk tolerance for the client, determining a recommended asset

allocation (see abstract); providing a database with ratings for different financial assets (see column 6 lines 13-37); identifying one or more assets in the client's portfolio that are recommended to be sold (see FIG.1); wherein an asset is recommended to be sold based on one of the following criteria: (1) the asset is recommended to be sold to achieve a recommended asset allocation (2) the asset is recommended to be sold based on a specific client preference, (3) the asset is recommended to be sold in order to achieve sector diversification, (4) the asset is recommended to be sold based on a poor rating for the asset in the database, (5) the asset is recommended to be sold in order to reduce concentration in the asset, or (6) the asset is recommended to be sold to realize tax loss harvesting;

Ray does not teach generating a plurality of tables wherein each asset of the one or more identified assets recommended to be sold is included in one of the tables, wherein each table corresponds to a reason that identifies the basis for recommending that assets contained in the table be sold, and wherein the basis correlates to an investment strategy for the client's portfolio.

Reese teaches identifying in a table the basis for recommending the sale or purchase of an asset (see FIG.5). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the method for providing financial advice of Ray with identifying the basis for recommending the sale or purchase of an asset as taught by Reese. One skilled in the art would have been motivated to make the modification for increased transparency. Reese does not explicitly teach arranging the information so that each table corresponds to a specific reason. However, modifying the layout of information such that each table corresponds to a reason constitutes a mere rearrangement of data which does not patentably distinguish the claimed invention from the prior art.

Ray does not teach for each of the one or more identified assets recommended to be sold, generating a list of alternative client portfolio assets recommended to be sold instead of the identified asset.

Hoffman teaches for each of one or more identified assets recommended to be sold, generating a list of alternative client portfolio assets recommended to be sold instead of the identified asset (see abstract, column 9 lines 10-15).

Therefore, it would have been obvious to one skilled in the art to modify the method of providing financial advice of Ray further with for each of the one or more identified assets recommended to be sold, generating a list of alternative client portfolio assets recommended to be sold instead of the identified asset. One skilled in the art would have been motivated to make the modification for to provide the user with more options.

Regarding claim 3,

Ray teaches providing a database with ratings for different financial assets (see column 6 lines 13-37). Ray does not explicitly teach wherein each table contains one or more rows and a plurality of columns and at least one of the columns indicates a rating from the database wherein the rating corresponds to the asset that corresponds to the row where the rating is provided.

Reese teaches wherein each table contains one or more rows and a plurality of columns and at least one of the columns indicates a rating wherein the rating corresponds to the asset that corresponds to the row where the rating is provided (see FIG.5). It would have been obvious to one skilled in the art at the time of invention to modify Ray further with wherein each table contains one or more rows and a plurality of columns and at least one of the columns

indicates a rating from the database wherein the rating corresponds to the asset that corresponds to the row where the rating is provided. One skilled in the art would have been motivated to make the modification because ratings may be helpful in investing.

Regarding claim 6,

Independent claim 6 recites limitations similar to those found in claim 1. (See rejection of claim 1 above).

Claim 6 additionally recites identifying a second set of assets recommended to be purchased and included in the client's portfolio, and for at least one asset in the second set of assets, providing a group of alternative recommended assets to purchase instead of the at least one asset. Ray teaches identifying a second set of assets recommended to be purchased and included in the client's portfolio (see FIG.1). Hoffman teaches for at least one asset in the second set of assets, providing a group of alternative recommended assets to purchased instead of the at least one asset (see column 9 lines 10-15). For reasons similar to those given as per the rejection of claim 1, it would have been obvious to one skilled in the art to modify Ray with for at least one asset in the second set of assets, providing a group of alternative recommended assets to be purchased instead of the at least one asset (claim 1 recites recommending alternative assets to sell while claim 6 recites recommending alternative assets to purchase).

Claim 6 additionally recites wherein the identification of the first set of assets takes into account the ratings for assets provided in the database; wherein the identification of the second set of assets takes into account the ratings for assets provided in the database. Ray teaches taking into account the ratings for assets in identifying whether the assets should be sold or purchased (see column 6 lines 15-37).

Claim 6 additionally recites wherein if a client sells the first set of assets and purchases the second set of assets, an asset allocation for the client's portfolio will be closer to the recommended asset allocation than if the client does not make the purchases or sales. Hoffman teaches wherein if a client sells the first set of assets and purchases the second set of assets, an asset allocation for the client's portfolio will be closer to the recommended asset allocation than if the client does not make the purchases or sales (see abstract, column 9 lines 10-15). It would have been obvious to one skilled in the art to modify the method of providing financial advice of Ray further with wherein if a client sells the first set of assets and purchases the second set of assets, an asset allocation for the client's portfolio will be closer to the recommended asset allocation than if the client does not make the purchases or sales. One skilled in the art would have been motivated to make the modification in order to still satisfy the original investment goals.

Regarding claim 8,

Ray does not teach generating a plurality of tables wherein each asset of the one or more identified assets recommended to be purchased is included in one of the tables.

Reese teaches identifying the basis for recommending the sale or purchase of an asset in a table (see FIG.5). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the method for providing financial advice of Ray with identifying the basis for recommending the sale or purchase of an asset as taught by Reese. One skilled in the art would have been motivated to make the modification for increased transparency. Reese does not explicitly teach arranging the information so that each table corresponds to a specific reason. However, modifying the layout of information such that each table corresponds to a

Art Unit: 3693

reason constitutes a mere rearrangement of data which does not patentably distinguish the claimed invention from the prior art.

Regarding claim 9,

Ray teaches wherein an asset is recommended to be sold based on one of the following criteria: (1) the asset is recommended to be sold to achieve a recommended asset allocation (2) the asset is recommended to be sold based on a specific client preference, (3) the asset is recommended to be sold in order to achieve sector diversification, (4) the asset is recommended to be sold based on a poor rating for the asset in the database, (5) the asset is recommended to be sold in order to reduce concentration in the asset, or (6) the asset is recommended to be sold to realize tax loss harvesting;

Regarding claim 10,

Ray teaches wherein the identification of assets held in a client's portfolio includes identifying multiple accounts owned by the client and identifying all of the assets held in each of the multiple accounts (see column 9 lines 14-22).

Regarding claim 14,

Independent claim 14 contains similar limitations to those found in claim 1 and 6 (see rejections of those claims above).

Regarding claim 17,

The claim contains similar limitations to those found in claim 1 (see rejection above).

Art Unit: 3693

Regarding claim 18,

The claim contains similar limitations to those found in claim 3 (see rejection above).

Regarding claims 19 and 20,

Hoffman teaches for each of one or more identified assets recommended to be sold or purchased, generating a list of alternative client portfolio assets recommended to be sold or purchased instead of the identified asset (see abstract, column 9 lines 10-15). Therefore, it would have been obvious to one skilled in the art at the time of invention to display the group of recommended alternative assets that can be sold or purchased in place of the first asset in response to a user selecting an edit field, such as a drop-down box.

Regarding claim 23,

Ray teaches wherein the reason for recommending the purchase of the asset is related to the client's preferences and risk tolerance (see column 5 lines 1-5).

Regarding claim 24,

Ray teaches wherein the reason for recommending the purchase of the asset is further related to the rating of the asset in the database (see column 6 lines 13-37).

Regarding claim 25,

Ray teaches wherein the reason for recommending the purchase of the asset is independent of another client portfolio.

3. Claims 4, 5, 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray in view of Reese, further in view of Hoffman, further in view of Bove (US Patent 7,149,713).

Regarding claim 4,

Ray does not explicitly teach wherein the preferences for the client include an identification of specific assets that a client wants to sell.

Bove teaches wherein the preferences for the client include an identification of specific assets that a client wants to sell (see column 2 lines 20-22). It would have been obvious to one skilled in the art at the time of invention to modify the method for providing financial advice of Ray further with client preferences indicating specific assets that a client wants to sell. One skilled in the art would have been motivated to make the modification for customer satisfaction.

Regarding claim 5,

Ray does not explicitly teach wherein the preferences for the client include an identification of specific assets that a client wants to hold.

Bove teaches wherein the preferences for the client include an identification of specific assets that a client wants to hold (see column 2 lines 20-22). It would have been obvious to one skilled in the art at the time of invention to modify the method for providing financial advice of Ray further with client preferences indicating specific assets that a client wants to hold. One skilled in the art would have been motivated to make the modification for customer satisfaction.

Regarding claim 11,

Ray does not explicitly teach wherein the client preferences include an identification of specific assets held in the client's portfolio that the client does not want to sell.

Bove teaches wherein the client preferences include an identification of specific assets held in the client's portfolio that the client does not want to sell (see column 2 lines 20-22). It would have been obvious to one skilled in the art at the time of invention to modify the method for providing financial advice of Ray further with client preferences indicating held in the client's portfolio that the client does not want to sell. One skilled in the art would have been motivated to make the modification for customer satisfaction.

4. Claims 15, 21-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray in view of Reese, further in view of Hoffman, further in view of Sloan (US PG-Pub 2002/0147671).

Regarding claim 15,

Ray teaches recommending the sale of holdings in a security in order to achieve a predetermined asset allocation where an asset has a rating in the database which indicates poor future expected performance.

Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the recommending the sale of holdings in a security of Ray with recommending such that the security will represent no more than 20% of the client's portfolio. One skilled in the art would have been motivated to make the modification for the benefit of achieving diversification.

Ray does not explicitly teach where a first group of securities are of a first sector type, and where the first group of securities are more than 20% above a recommended benchmark

sector weight for the first sector type, recommending the sale of some of the securities in the first group to bring an exposure to the first sector type down to 10% above the recommended benchmark sector weight for the first security type.

Sloan teaches recommending the sale of securities within a sector to bring an exposure to sector down.

Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the recommending the sale of securities of Ray with where a first group of securities are of a first sector type, and where the first group of securities are more than 20% above a recommended benchmark sector weight for the first sector type, recommending the sale of some of the securities in the first group to bring an exposure to the first sector type down to 10% above the recommended benchmark sector weight for the first security type. One skilled in the art would have been motivated to make the modification for the benefit of achieving diversification.

Regarding claim 21,

Ray teaches recommending the selling of a first asset which represents an over concentration of the portfolio in the first asset;

Ray does not explicitly teach recommending the selling of a second asset where the second asset is part of a group of assets in a sector where the group of assets in the sector exceeds a targeted allocation for the sector.

Sloan teaches recommending the selling of a second asset where the second asset is part of a group of assets in a sector where the group of assets in the sector exceeds a targeted allocation for the sector (see FIG. 5 element 240).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the recommending the sale of an asset of Ray with recommending the sale of an asset where the asset is part of a group of assets in a sector where the group of assets in the sector exceeds a targeted allocation for the sector. One skilled in the art would have been motivated to make the modification to reduce risk through diversification.

Regarding claim 22,

Ray does not explicitly teach recommending the selling of a third asset in order to realize a capital loss.

Hoffman teaches recommending the selling of an asset in order to realize a capital loss (see column 19, lines 21-22). It would have been obvious to one skilled in the art at the time of invention to modify the method of providing financial advice of Ray further with recommending the selling of an asset in order to realize a capital loss. One skilled in the art would have been motivated to make the modification in order to reduce taxable capital gains.

5. Claim 1, 3, 6, 8, 9, 10, 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ray in view of Reese, further in view of Hoffman, further in view of Official Notice.

Regarding claim 27,

Ray teaches identifying assets held in the client's portfolio wherein the portfolio includes assets spread across the included accounts (see column 9 lines 14-22).

Ray does not explicitly teach receiving all the account numbers for a plurality of investment accounts the client has at a particular financial institution; recommending placing assets into the included accounts in a tax efficient manner (see abstract, column 4 lines 48-67).

Bove teaches receiving all the account numbers for a plurality of investment accounts the client has at a particular financial institution; recommending placing assets into the included accounts in a tax efficient manner (see abstract, column 4 lines 48-67). It would have been obvious to one skilled in the art at the time of invention to modify the method of providing financial advice of Ray further with recommending placing assets into the included accounts in a tax efficient manner. One skilled in the art would have been motivated to make the modification to reduce capital gains taxes.

Ray does not explicitly teach; receiving preferences wherein the preferences also include which of the plurality of accounts are to be included in financial advisory considerations.

Official Notice is taken that receiving preferences specifying which accounts to include in financial advisory considerations was old and well known at the time of invention. For example, when one goes to a full service broker who manages multiple accounts, such as an IRA and an individual account, that person may specify the account in which he wants to receive financial advice.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the method of providing financial advice of Ray further with receiving preferences wherein the preferences also include which of the plurality of accounts are to be included in

financial advisory considerations. One skilled in the art would have been motivated to make the modification because a client may want to focus on one account at a time since the client may have differing objectives for each account.

Response to Arguments

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

9/12/2008